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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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David Shen

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BRINKS HOFER GILSON & LIONE / YAHOO! OVERTURE

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CHICAGO, IL 60610

EXAMINER

CHAMPAGNE, DONALD

ART UNIT

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3688

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/633,168	Applicant(s) SHEN ET AL.	
	Examiner Donald L. Champagne	Art Unit 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1 and 3-19 are rejected under 35 U.S.C. 101 because the claimed invention is not directed to statutory subject matter. Based on Supreme Court precedent, to be patent eligible under 35 U.S.C. 101 a method/process claim must (1) be tied to a particular machine or apparatus or (2) transform a particular article into a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 70 (1972); *Diamond v. Diehr*, 450 U.S. 192 (1981); *Parker v. Flook*, 437 U.S. 589 n.9 (1978); and *Cochrane v. Deener*, 94 U.S. 780, 788 (1876)). Furthermore, the Supreme Court held that the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patentability (*Benson*, 409 U.S. 71-72). The involvement of the machine or transformation must not merely be insignificant extra-solution activity (*Flook*, 437 U.S. 590).
3. The claims 1 and 3-19 are tied to a machine or apparatus, as a "computer implemented method" using a "processor", but this is at best a nominal recitation that does not qualify as a *specific* machine or apparatus and does not impose a *meaningful* limitation. The claimed limitation appears only in a preamble, which is not given patentable weight. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).
4. Claims 20-36 are rejected under 35 U.S.C. 101 because the claimed invention, which is interpreted to be a computer program, does not fall within at least one of the four statutory categories of invention enumerated by 35 U.S.C. 101 (MPEP § 2106.IV.B). Computer programs are nonstatutory functional descriptive material (MPEP § 2106.01.I, last para.).

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5. Claims 1 and 3-36 are rejected under 35 U.S.C. 101 because the claimed invention cannot produce a concrete (i.e., repeatable) result (MPEP § 2106.IV.C.2(2)c)). The invention does not disclose an algorithm or objective means for "calculating one or more performance scores" (e.g., at claim 1 line 6).

Applicability of 35 USC 112, 6th Paragraph

6. It appears the applicant is attempting to invoke 35 U.S.C. 112, 6th paragraph in claims 20-36 by using "means-plus-function" language, such as "means for collecting" (claim 20 line 3). In order to successfully invoke the sixth paragraph, a three-prong test must be met (MPEP § 2181.I): (1) the claim limitations must use the phrase "means for" or "step for; (2) the "means for" or "step for" must be modified by functional language; and (3) the phrase "means for" or "step for" must not be modified by sufficient structure, material, or acts for achieving the specified function. The above claims pass the three prong test, so 35 U.S.C 112, 6th paragraph has been successfully invoked. The Examiner will consider the means to perform the claimed functions as the means disclosed, specifically in para. [0096] *et seq.* of the published application (US 20040204983A1).

Advisory Claim Rejections - 35 USC § 112

7. It is Office policy to make the following rejections under 35 USC 112 whenever an applicant claims a calculation without disclosing an algorithm or other objective means for performing said calculation. Applicant is put on notice that the following rejection would be applied to the instant claims if this were not a final rejection and would be applied to any future amended claims as appropriate.
8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 1 and 3-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In each independent claim 1 and 20, (e.g., at claim 1 line 6), "calculating one or more

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performance scores” is not enabled because a person skilled in the art would not be able to practice the invention without undue experimentation.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1 and 3-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In each independent claim 1 and 20, (e.g., at claim 1 line 6), “calculating one or more performance scores” is indefinite because the applicant has failed to disclose any objective means or algorithm by which to perform said calculation (*Aristocrat Techs. Austl. Pty Ltd. v Inter Game Tech.*, 521 F.3d 1328, 1333 (Fed. Cir. 2008)).

Claim Rejections - 35 USC § 102 and 35 USC § 103

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1, 3-9, 11, 14, 16-28, 30 and 34-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Srinivasan et al. (US 20020042738A1).

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15. Srinivasan et al. teaches (independent claims 1 and 20) a computer-implemented method for determining, through the use of a processor and a computer application for determining/evaluating the performance of an ad, the method comprising:

collecting a plurality of input data points (*different formats of the same advertisement*, para. [0029], and *experiment parameter values*, para. [0059]);

collecting a plurality of outcome data points (*statistics on the audience response*, para. [0029], *output from the Server Module 260*, para. [0059]); and

calculating one or more performance scores (*optimal values of key market decision variables*, para. [0025], *statistics on the audience response*, para. [0029], and *the buy-rate*, para [0086]) based upon the input data points and output data points;

wherein the input data points include data points about an advertisement description (*different formats of the same advertisement*, para. [0029]) and wherein the outcome data points include one or more of data points about user opinions and data points about user experience (*statistics on the audience response*, para. [0029]).

16. Srinivasan et al. also teaches at the citations given above claims 6-8, 9 (inherently, to gather *statistics on the audience response*), 14, 16, 18, 24-26 and 28.

17. Srinivasan et al. also teaches: claims 3, 4, 21 and 22 (para. [0058], where *an employee* reads on “an Evaluator”); claims 5 and 23 (para. [0087]); and claims 11, 17, 19, 27, 30 and 34-36 (para. [0049]).

18. Claims 10, 12, 13, 15, 29 and 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Srinivasan et al. (US 20020042738A1). Srinivasan et al. does not teach (claims 10 and 29) a pop-up window and (claims 12, 13, 15 and 31-33) soliciting comments that are analyzed for key words. However, the reference does teach determining the *audience response* (para. [0029]) and that *surveys* of the audience are common (para. [0022]). Official notice is taken (MPEP § 2144.03) that pop-up windows were a common means of presenting surveys at the time of the instant invention. Asking for comments in the surveys was also common, and key-word analysis would have been an obvious mechanical efficiency in analyzing these comments.

19. Traverse of the taking of Official Notice - On pp. 13-14 of the arguments filed 26 September 2008, applicants have traversed the examiner’s taking of official notice. However, applicant

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has not provided adequate information or argument so that *on its face* it creates a reasonable doubt regarding the circumstances justifying the official notice (MPEP § 2144.03). An effective traverse must be based on alleged evidence, not mere denial. Applicants argues that they are "not aware" that these limitations are common. This is not meaningful evidence. Applicant could, for example, have gone on record that they had searched for one or more of the limitations without finding it. The examiner would then have been compelled to produce a references in order to maintain the tasking of official notice. But applicant submitted no such evidence. Therefore, the presentation of a reference to substantiate the official notice is not deemed necessary. The examiner's taking of official notice is maintained.

Response to Arguments

20. Applicant's arguments filed with an amendment on 26 September 2008 have been considered in the revised rejection presented above. Applicants made few significant amendments or compelling arguments. The following comments might be helpful. It need be noted that these comments are based on the current case law, which is changing quickly.
21. The instant claims are not patentable in part because they are not *clearly* associated with an algorithm or other objective means for calculating performance scores. Basic to this problem is the legal concept of *clear definition*. Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...". An example does not constitute a "clear definition" beyond the scope of the example.
22. The instant application contains no algorithm or other *clear definition* for its calculation means. The spec. does give formulas which might qualify as an algorithm (e.g., "Expression 12" at para. [0086] of the published application), but it is disclosed that these formulas "may"

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be the means for calculating a score, which does not meet the requirements for a "clear definition". However, this or other parts of the spec. might qualify as a meaningful limit if claimed expressly. The essential requirement is that one of ordinary skill in the art must be able to take certain inputs and be able to produce certain outputs without undue experimentation.

23. Applicants can overcome the rejection of claims 20-36 under 35 USC § 101 (para. 4 above) by claiming a computer readable medium containing an executable method (not vice-versa, as is the case now).

Conclusion

24. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

25. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717. The fax phone number for all *formal* matters is 571-273-8300.

27. The examiner's supervisor, James W. Myhre, can be reached on 571-272-6722.

28. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information

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for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

29. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that “disposal or clarification for appeal may be accomplished with only nominal further consideration” (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.
30. Applicant may have after final arguments considered and amendments entered by filing an RCE.
31. Applicant is advised that, unless a proposed amendment is filed after final and the examiner returns an advisory action with block 3(a) checked (signifying that further search or consideration is required), an amendment filed with an RCE **COULD BE MADE FINAL IN THE FIRST ACTION** in accordance with MPEP § 706.07(b).
32. **ABANDONMENT** – If examiner cannot by telephone verify applicant’s intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office’s web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

31 December 2008

/Donald L. Champagne/
Primary Examiner, Art Unit 3688